

REMARKS

By this Amendment, Applicants amend claims 1, 9, 17, 21, 24, and 27 for clarity. New claims 31 and 32 are also added to protect additional aspects of Applicants' invention. Support for new claims 31 and 32 can be found in the specification at least at page 4, line 11 through page 5, line 2. Claims 1-32 are now pending in this application.

In the Final Office Action¹, the Examiner rejected claims 1-2, 4-6, 9-10, 12-13, 21, and 24 under 35 U.S.C. § 102(e) as anticipated by Bull et al. (U.S. Patent No. 5,995,943); rejected claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over Bull; rejected claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as obvious over Bull in view of Portuesi (U.S. Patent No. 5,774,666); rejected claims 17-19 and 27-29 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray (U.S. Patent No. 6,061,659); and rejected claims 20 and 30 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Portuesi.

Applicants respectfully traverse the rejection of claims 1-2, 4-6, 9-10, 12-13, 21, and 24 under 35 U.S.C. § 102(e) as anticipated by Bull. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

Claim 1 recites an “apparatus for hyperlinking specific words in content to turn the words into advertisements” including, among other things, “an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to an advertiser-chosen word or phrase present in a content file to link said advertiser-chosen word or phrase to said advertiser web page.” Bull does not disclose at least these features.

In making the rejection in the Final Office Action, the Examiner alleged that Bull discloses providing a hyperlink “to a word or phrase (e.g., Inns on the West Coast, col. 15, lines 39-42) in a content file to link an Internet-enabled web browsing device connected to the Internet to said advertiser web page (col. 15, lines 24-25).” See Final Office Action, page 3. Bull, however, does not teach the features alleged by the Examiner. Namely, Bull does not teach “providing a hypertext anchor to an advertiser-chosen word or phrase present in a content file to link said advertiser-chosen word or phrase to said advertiser web page,” as recited in claim 1. The portion of the Examiner’s rejection alleging that Bull discloses this feature is in error.

Specifically, in Bull, an example is given that, “if the user accesses web pages for ‘Holiday Inns on the West Coast,’ the insertion mechanism would be established to automatically insert ads for ‘Hilton Inns on the West Coast.’” Bull, col. 15, lines 39-42. However, this passage merely discloses inserting ads for Hilton Inns on the West Coast on the web page for Holiday Inns on the West Coast. It does not, however, as the Examiner appears to contend, disclose “providing a hypertext anchor to an advertiser-

chosen word or phrase present in a content file to link said advertiser-chosen word or phrase to said advertiser web page,” as recited in claim 1. Instead, in Bull, “ads/coupons are inserted alongside displayed data (text, picture, or index displays....” See col. 9, lines 37-39. In other words, Bull places an ad along with displayed data, i.e., the ad is inserted in **addition** to existing content.

Furthermore, while the Examiner also cites Bull at col. 15, lines 24 and 25, which states that an “ad will be inserted based on the content of the existing web page being read,” Bull continues to explain at lines 27-29, that “[w]hen certain text patterns are observed (or close matches are observed), an advertisement is inserted into the display” (emphasis added). In other words, the actual advertisement, whether it be text or a graphic, is inserted in **addition** to the existing content. Accordingly, the description that the Examiner cited at col. 15, lines 39-42, merely discloses inserting **additional** text or a graphic on the web page for Holiday Inns on the West Coast. That, however, does not constitute at least “providing a hypertext anchor to an advertiser-chosen word or phrase present in a content file to link said advertiser-chosen word or phrase to said advertiser web page.” Bull therefore does not teach all of the elements of claim 1.

Since Bull does not teach all of the elements of claim 1, Applicants respectfully request the Examiner to withdraw the section 102(e) rejection of claim 1, and claims 2 and 4-6, which depend therefrom.

Independent claims 9, 21, and 24 were rejected using similar reasoning. These claims, while of a different scope, include recitations similar to allowable claim 1. Accordingly, the Examiner should withdraw the rejection of claims 9, 21, and 24.

Dependent claims 10 and 12-13, which depend from allowable independent claim 9, are also allowable.

Applicants respectfully traverse the rejection of claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) as obvious over Bull. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 3 and 7 depend from claim 1, claims 11-15 depend from claim 9, claim 22 depends from claim 21, and claim 25 depends from claim 24. As discussed above, Bull does not teach every element of independent claims 1, 9, 21, and 24. Further, nothing in Bull suggests this claim element and the Examiner does not allege any suggestion of it. Instead, in Bull, advertisements are instead inserted alongside displayed data.

Applicants again object, for at least the reasons provided in the Request for Reconsideration filed November 1, 2004, to the Examiner's taking of Official Notice at page 3 of the Final Office Action wherein the Examiner alleges using a script to overwrite existing HTML of a content file "is inherent whenever adding an anchor to an

existing content file.” See Final Office Action, pages 3-4, where the Examiner takes Official Notice that such features are “common and well known practices.” Applicants again respectfully request that the Examiner provide the explicit basis on which the Examiner regards the matter as subject to Official Notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made, or else withdraw the rejection.

The Examiner should withdraw the rejection of claims 3, 7, 11, 14-15, 22, and 25 under 35 U.S.C. § 103(a) for at least the above reasons.

Applicants respectfully traverse the rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as obvious over Bull in view of Portuesi. Claim 8 depends from claim 1, claim 16 depends from claim 9, claim 23 depend from claim 21, and claim 26 depends from claim 24. As discussed above, Bull fails to teach or suggest every element of claims 1, 9, 21, and 24 and their dependent claims. Furthermore, Portuesi does not cure this defect. Portuesi disclose a system that adds a Uniform Resource Location (URL) track into a movie file in addition to audio and video tracks. See col. 4, line 63 to col. 5, line 5. Nothing in the reference discloses or suggests at least “an ad server connected to the Internet, wherein the ad server provides means for providing a hypertext anchor to an advertiser-chosen word or phrase present in a content file to link said advertiser-chosen word or phrase to said advertiser web page,” as recited in claim 1, for example.

Additionally, claims 8, 16, 23, and 26 recite linking to an advertiser web page using a tracking URL. This claim element is not taught or suggested by Bull or Portuesi. Regarding this claim element, the Examiner pointed to a teaching in Portuesi of a movie

file with a plurality of tracks, including an audio track, an image track, and a URL track.

Portuesi, col. 4, lines 63-65. The multiple tracks of a movie file are unrelated to linking to a web page using a tracking URL, as recited in claims 8, 16, 23, and 26.

Consequently, the teachings of Portuesi do not constitute a “tracking URL” as recited in Applicants’ claims.

Furthermore, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine Portuesi with Bull because Portuesi allegedly teaches “linking to a time-based medium.” See Final Office Action, page 4. Instead, however, Portuesi teaches away from Applicants’ claimed invention. Portuesi uses a time-based medium, such as a movie file, embedded with a URL in a track of the movie file. This URL is used to activate the URL during display of the movie. See Abstract. However, this has nothing to do with Applicants’ claimed “tracking URL.” Applicants note that a “tracking URL” is discussed in the specification at least at page 5, lines 17-22, for example.²

For at least these reasons, the references fail to teach or suggest all elements of claims 8, 16, 23, and 26. Applicants therefore request the reconsideration and withdrawal of the section 103 rejections of these claims.

Applicants respectfully traverse the rejection of claims 17-19 and 27-29 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray. Claim 17 recites, among other things, “altering the HTML coding of content for an Internet-displayed file to include a

² In referring to the specification herein, it is to be understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

hypertext anchor on an advertiser-chosen word or phrase present in the content to link to an advertiser web page.” Claim 27 recites, among other things, “altering the document file with software to include a hypertext anchor on an advertiser-chosen word or phrase present in the document file to link to an advertiser document.” As discussed above, Bull does not disclose or suggest at least these features.

Furthermore, Murray does not make up for the deficiencies of Bull. Murray merely discloses a system that uses HTML documents to provide content through a browser using pre-defined HTML tags. See col. 5, lines 14-16; col. 6, lines 32-39. Nothing in the reference suggests altering the HTML coding to include a hypertext anchor on an advertiser-chosen word or phrase to link an advertiser web page. Accordingly, Murray does not disclose or suggest all elements of claims 17 and 27. Dependent claims 18-19 and 28-29 depend from allowable independent claims 17 and 27 and are allowable at least due to their dependence from allowable claims.

Applicants again traverse the Examiner’s taking of Official Notice with respect to claims 19 and 29, and respectfully request that the Examiner provide the explicit basis on which the Examiner regards the matter as subject to Official Notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made, or else withdraw the rejection.

Applicants respectfully traverse the rejection of claims 20 and 30 under 35 U.S.C. § 103(a) as obvious over Bull in view of Murray and further in view of Portuesi.

Claims 20 and 30 depend from allowable claims 17 and 27. As discussed above, Bull and Murray do not disclose or suggest all of the features of claims 17 and 27. Portuesi does not make up for the deficiencies of Bull and Murray. Furthermore, in

rejecting claims 20 and 30 the Examiner has again alleged that Portuesi teaches Applicants' claimed "tracking URL." See Final Office Action, page 5. Applicant disagrees for at least the reasons provided above, and again submits that Portuesi's use of a time-based medium, such as a movie file, embedded with a URL in a track of the movie file, does not constitute Applicants' claimed "tracking URL." Accordingly, the Examiner should withdraw the rejection and allow claims 20 and 30.

Applicants submit that new claims 31 and 32 are neither disclosed nor suggested by the applied prior art, taken alone, or in combination. Accordingly, Applicants respectfully request that the Examiner allow new claims 31 and 32.

CONCLUSION

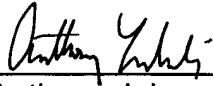
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 27, 2005

By: 
Anthony J. Lombardi
Reg. No. 53,232